

Application No.: 10/008,468

Case No.: 55525US011

Remarks

Claims 32-39 are pending.

Applicants gratefully acknowledge Examiner's withdrawal of the Restriction Requirement mailed August 4, 2004. (Office Action mailed January 25, 2005, ¶ 1.)

§ 112, First Paragraph Rejection

Claims 32-39 stand rejected under 35 USC § 112, first paragraph, as purportedly failing to comply with the written description requirement.

As filed, the present disclosure describes webs comprising embedded particles, wherein the particles are uniformly distributed, and wherein substantially all of the particles are randomly spaced from each other. (See, e.g., page 11, lines 3-10.) Independent claim 38 requires that the embedded particles be non-magnetic. According to the Patent Office, the specification as originally filed provides no support for "non-magnetic particles." (Id. at ¶ 2.) Applicants respectfully traverse.

The written description requirement is met if the disclosure relied upon reasonably conveys to one skilled in the relevant art that the inventors had possession of the claimed subject matter. *Lampi Corp. v. American Power Products, Inc.*, 228 F.3d 1365, 1378, 56 USPQ2d 1445, 1455 (Fed. Cir. 2000). The disclosure does not have to provide *in haec verba* support for the claimed subject matter; the disclosure need only convey with reasonable clarity to those skilled in the art that the inventor was in possession of the invention. *Purdue Pharma L.P. v. Faulding Inc.*, 230 F.3d 1320, 1323, 56 USPQ2d 1481, 1483 (Fed. Cir. 2000) (internal citations omitted).

As filed, the disclosure explicitly states that the embedded particles "can be any particles that can enhance existing web properties, such as controlling adhesion, or provide additional utility." (Page 4, lines 26-28.) In addition, the disclosure provides an extensive and diverse list of exemplary particles, which may be magnetic or non-magnetic, including: "bare glass beads; expandable microspheres; core/shell particles; metal beads; beads made from oxides, nitrides, sulfates, or silicates such as silver oxide or boron nitride, titania, ferric oxide, silica, magnesium sulfate, calcium sulfate, or beryllium aluminum silicate; hollow glass bubbles; polymeric

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spheres; ceramic microspheres; magnetic particles; and microencapsulated particles.” (Page 4, lines 28-32.)

Although the disclosure may not explicitly use the phrase “non-magnetic particles,” the law does not require such *in haec verba* support. *Purdue Pharma L.P.*, 230 F.3d at 1323; 56 USPQ2d at 1483. Applicants respectfully submit that the explicit statement that “any” particle can be used, as well as the numerous examples of non-magnetic particles reasonably convey to one skilled in the relevant art that the inventors had possession of the claimed subject matter. Therefore, the written description requirement of 35 U.S.C. § 112, first paragraph has been met.

In *Lampi Corp. v. American Power Products, Inc.*, the patentee’s invention was a miniature self-supporting fluorescent light that can be plugged into a standard outlet. 32 F.3d at 1367, 56 USPQ2d at 1446. The light comprised a self-supporting elongated housing having two separable half-shells. 32 F.3d at 1369, 56 USPQ2d at 1448. American Power Products, Inc. argued that the original specification only described identical half-shells and, thus, did not provide support for claims encompassing non-identical half-shells. 32 F.3d at 1377-78, 56 USPQ2d at 1455. The Court of Appeals for the Federal Circuit rejected this argument, holding that the original disclosure satisfied the written description requirement of 35 U.S.C. § 112, first paragraph for the later filed claims directed toward “non-identical” half shells. 32 F.3d at 1377-78, 56 USPQ2d at 1455.

The court noted that, although the specification twice referred to “identically shaped” or “identical” half-shells, this was merely a preferred embodiment. The court further noted that the specification also included references to half-shells without the modifier “identical” or “identically shaped,” “indicating that identical half-shells are not critical to the invention.” 32 F.3d at 1378, 56 USPQ2d at 1455. Thus, literally describing identical half-shells along with other types of shells supported claims to both identical and non-identical half-shells.

In the present disclosure, Applicants often used the term “particles” without the modifier “magnetic” and explicitly stated that “any” particles can be used. (See, e.g., page 4, lines 23-28; and page 6, lines 21-31.) The disclosure describes numerous non-magnetic particles (page 4, lines 26-32) and provides examples of webs comprising embedded non-magnetic particles

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(pages 28-26). Although "magnetic" particles are mentioned, such particles are not described as "required" or even "preferred," but merely as one exemplary category of useful particles.

In summary, Applicants respectfully submit that the disclosure relied upon reasonably conveys to one skilled in the relevant art that the inventors had possession of the claimed subject matter in the manner required by 35 U.S.C. §112, first paragraph, as elucidated by the Court of Appeals for the Federal Circuit. The disclosure explicitly states that the particles can be any particles and provides numerous examples of non-magnetic particles. In addition, the disclosure describes "magnetic particles" as one subgenus of exemplary particles. Other portions of the disclosure, including the Examples, make it clear to one of ordinary skill in the art that non-magnetic particles are also suitable. Thus, the disclosure leads anyone of ordinary skill in the art to immediately discern non-magnetic particles as included in Applicants' invention, and Applicants had possession of the claimed subject matter.

For at least these reasons, the disclosure fully complies with the written description requirement. Therefore, the rejection of claims 32-39 under 35 USC § 112, first paragraph is unwarranted and should be withdrawn.

In view of the above, it is submitted that the application is in condition for allowance. Reconsideration of the application is requested, and allowance of claims 32-39 at an early date is solicited. If any issues remain, the Examiner is invited to telephone the Applicant's representative at the number below.

Respectfully submitted,

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